



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/258,609 02/26/99 KOBATA

H EPC-009

EXAMINER

TM02/0716

FISH & RICARDSON P.C.  
601 THIRTEENTH STREET, NW  
WASHINGTON DC 20005

KANG, P

ART UNIT

PAPER NUMBER

2152

DATE MAILED:

07/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/258,609

Applicant(s)

KOBATA ET AL.

Examiner

Paul H Kang

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 2152

1. The drawings are objected to because of the items cited on the attached form PTO-948.

Correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1- 2, 5-11, 13, 16-17, 19, 23, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Bobo, II, US Pat. No. 5,675,507.

4. As to claims 1, 13 and 16, Bobo discloses an apparatus for delivering a document to a receiving station over a network, comprising:

a server system connected to the network and storing digital information received over the network (abstract, col. 4, lines 54-67); and

a sending system connected to the network and transmitting a notification to the receiving system, the notification signifying that the sending system is transmitting the digital information over the network to the server system and that the digital information may be accessible by the receiving system at the server system (abstract, col. 4, line 23 – col. 5, line 40).

5. As to claims 2 and 23, Bobo teaches the server system receives the digital information from the sending system (abstract, col. 4, lines 54-67).

6. As to claims 5-7, Bobo teaches a storage device in communication with the server and wherein the server system stores the digital information at an address location of the storage device, and wherein the server system includes a page providing a path by which the receiving system can access the digital information at the address location, wherein the notification has a resource locator which addresses the page on the server system (abstract, col. 4, lines 54-67 and col. 6, line 66 – col. 8, line 40).

7. As to claims 8 and 27, Bobo teaches the page requests valid authentication information from the receiving system before granting access to the digital information (fig. 3 and col. 7, lines 25-37).

8. As to claims 9-11, Bobo teaches a page which provides access to a graphical window describing contents of the digital information and resource locators reference multiple locations in the storage device to access the data structure using the unique identifiers (abstract, col. 4, lines 54-67 and col. 6, line 66 – col. 7, line 50).

9. As to claims 17 and 19, Bobo teaches transmitting the digital information from the server system to the receiving system in response to a request from the receiving system and executing a server-side software through which the receiving system can obtain access to the digital information (abstract, col. 7, lines 39-67).

Art Unit: 2152

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-4, 12, 14-15, 18, 20-22, 24-26, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo, as applied above, in view of Masters, US Pat. No. 5,872,930.

12. As to claim 3-4, 12, 14-15 and 24-26, Bobo teaches the invention substantially as claimed. Bobo teaches a message delivery system comprising multiple computers, including senders, receivers and server, communicating over the internet (Bobo, col. 6, lines 20-56). However, Bobo does not explicitly teach a second server system in communication with the sending system and the first server system, wherein the first server system receives the digital information from the sending system via the second server system, acting logically as a single server system.

Masters teaches a email server system used to route a message through multiple servers based on server load (Masters, col. 2, line 18 – col. 4, line 35 and fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a second server into the system, as taught by Masters, into the system of Bobo for the purpose of increasing data transmission efficiency by distributing tasks among multiple servers.

Art Unit: 2152

13. As to claim 18 and 28-29, Bobo-Masters teaches the invention substantially as claimed. However, Bobo-Masters does not explicitly teach the step of tracking the digital information in real-time, confirming that the receiving system has completely received the digital information and notifying the sending system when the receiving system starts using the digital information.

Official notice is taken (see MPEP 2144.03) that tracking message transmission was well known in the computer networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a method of confirming that a message was completely received into the system of Bobo-Masters for the purpose of increasing data transmission reliability.

14. As to claims 20 and 21, Bobo-Masters teach the step of maintaining a page on the server system through which the receiving system can obtain access to the digital information and the notification includes the resource locator for accessing the page (Bobo, abstract, col. 4, lines 54-67 and col. 6, line 66 – col. 8, line 40).

15. As to claim 22, Bobo-Masters teaches the invention substantially as claimed. However Bobo-Masters does not explicitly teach the step of concurrently sending a notification and digital information.

Official notice is taken (see MPEP 2144.03) that concurrently transmitting a notification and a message was as well known in the computer networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a method of concurrently transmitting a notification and a message into the system

Art Unit: 2152

of Bobo-Masters for the purpose of increasing the rate and reliability of which the receiver receives a notification.

16. As to claims 30 and 31, Bobo-Masters teaches the invention substantially as claimed. However Bobo-Masters does not explicitly teach the step of canceling delivery after sending the digital information.

Official notice is taken (see MPEP 2144.03) that canceling a message was as well known in the computer networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a step to cancel a message anytime after it has been sent into the system of Bobo-Masters for the purpose of enhancing the control of the data transmission.

17. As to claim 32, Bobo-Masters teaches the invention substantially as claimed. However Bobo-Masters does not explicitly teach the step of restarting a connection after an interruption at the point of interruption.

Official notice is taken (see MPEP 2144.03) that restarting a connection at the point of interruption was well known in the networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated method to restart a connection at the point of interruption into the system of Bobo-Masters for the purpose of increasing system fault tolerance.

18. Applicant's arguments filed April 20, 2001 have been fully considered but they are not persuasive. The applicant argued in substance that the prior art of record "fails to describe or suggest having a sending system transmit a notification to a receiving system, with the notification signifying that the sending system is transmitting the digital information over the network to the server system and that the digital information may be accessible by the receiving system at the server system... [The prior art of record] receives/stores the messages (e.g., digital information) **and** sends the notification to the user."

The applicant argues limitations which are not essential to the scope of the prior art. The definiteness of the language employed must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Insofar, the claims have been given the broadest reasonable interpretation consistent with the specification and the prior art during the examination of this patent application since the applicant may then amend his claims, the thought being to reduce the possibility that after a patent is granted, the claims may be interpreted as giving broader coverage than is justified. Therefore, applicant's arguments regarding claims 1-32 are not given weight as to the patentability of the claimed subject matter.

Bobo discloses a MSDS server system which processes messages. This server system which has email capability, sends notification to a user that information has been received by the server from a sender. In distributed networked systems, such as the network taught by Bobo, messages are transferred from one user on the network to others on the network via multiple servers and gateways. These messages may undergo various processing and modification during transit, such in multi-protocol communications or proxy services.



The user notification, as taught by Bobo, is triggered and automatically transmitted to the user in response to the message transmitted by the sender. Additionally, the notification comprises information provided by the sender, such as the user computer's address. Therefore, in the system disclosed by Bobo, the sender sends a notification to the user, via the server, notifying receipt of information on the server.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2152

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-9731 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
Paul H Kang  
Examiner  
Art Unit 2152

July 16, 2001

  
MARK H. RINEHART  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100